REMARKS

This is intended as a full and complete response to the Final Office Action dated January 12, 2005, having a shortened statutory period for response set to expire on April 12, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-42 are pending in the application. Claims 1-42 remain pending following entry of this response.

Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kanno et al.* (US 6,526,424 B2, hereinafter *"Kanno"*) in view of *Anupam et al.* (US 6,535,912 B1, hereinafter *"Anupam"*). Applicants respectfully traverse the rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP § 2143. The present rejection fails to establish at least the third criteria of the *prima facie* case of obviousness because *Kanno* and *Anupam*, alone or in combination, do not teach show or suggest that if a first network information address stored in a bookmark data structure is not retrievable, identified embedded network information addresses are made available to a user via the stored bookmark.

The pending claims recite that if a first network information address stored in a bookmark data structure is not retrievable, identified embedded network information addresses are made available to a user via the stored bookmark. *See, e.g.,* Claim 1.

As an initial matter, Applicants note that in making the rejection, Examiner has split a condition precedent in the claims from the statement "identified embedded network information addresses available to a user via the stored bookmark". *Id.* Namely, in the pending claims, making the identified embedded information addresses available to a user via the stored bookmark *is conditioned on the first network information address not being retrievable. See, e.g.* Claim 1. The Examiner argues that

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the conditional limitation (wherein if the first network information address is not retrievable) is taught by *Kanno* and that the effect implemented upon satisfaction of the condition (i.e., "making the identified embedded network information addresses available to a user via the stored bookmark) is taught by *Anupum*. *See Response to Arguments* in *Final Office Action* dated Dec. 12, 2005, Pg. 14 and Pgs. 3-4, Item (e). However, by separating the condition from the rest of the element, the Examiner has reduced a monolithic element into constituent parts, thereby substantially changing the meaning of the collective claim language. Even assuming the Examiner were correct regarding the teachings of *Kanno* and *Anupum* as far as the individual constituent claim limitations of the element at issue, the Examiner's analysis has removed the conditionality from the element at issue. As a result, the Examiner has not made a *prima facie* case obviousness because instead of applying the references to the actual claim language, the Examiner has fundamentally changed the scope and meaning of the claim language to produce a modified, hypothetical claim, and then applied the references to the modified, hypothetical claim. Applicants submit, for reasons described below, that neither reference, alone or in combination, discloses making the identified embedded information addresses available to a user via the stored bookmark *conditioned on the first network information address not being retrievable*. Therefore, Applicants believe the claims are allowable and respectfully request allowance of the same.

Kanno is directed to a browser image display bookmark system (*See* Title). In *Kanno*, if the bookmarked page cannot be found, an error message is displayed (col. 19, line 65 to col. 20, line 3). Thus, *Kanno* does not teach, show, or suggest that if a first network information address stored in a bookmark data structure is not retrievable, identified embedded network information addresses are made available to a user via the stored bookmark.

Anupam allows a user to record a series of browsing steps (called traversal links) as a smart bookmark (*See* Abstract). In *Anupam*, where the smart bookmark retrieves stored traversal links related to the bookmarked requested web page, *the requested web page is available*. *See* Col. 9, Lines 20-21. This can be seen explicitly in Figure 4A (Items 401 and 402) and Figure 4B (Items 406 and 407) wherein the page *is*

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retrieved (Item 402) and subsequently *from the retrieved page* (Item 406), a matching link is found. <u>Thus, only when the underlying page is available may the underlying page be searched for the correct traversal links.</u> Col. 9, Lines 31-34, Col. 9, Lines 49-52. Accordingly, *Anupam*, at a minimum, does not teach, show, or suggest that *if a first network information address stored in a bookmark data structure is not retrievable,* identified embedded network information addresses are made available to a user via the stored bookmark. Therefore, the claims are believed to be allowable and allowance of the same is respectfully requested. A more detailed discussion of *Anupam* follows.

Anupam is directed to a method for creating and playing back a smart bookmark that automatically retrieves a requested web page through a plurality of intermediate web pages (*See* Title). *Anupam* allows a user to record a series of browsing steps as a smart bookmark (*See* Abstract). Each browsing step is stored as a link within the smart bookmark (*See* Fig. 2, Fig. 3, col. 7, line 50 to col. 8, line 18). The first step may be stored as an initial link and each subsequent step may be stored as a destination link (also referred to as a link traversal) (*Id.*). The browsing steps may then be played back by selecting the smart bookmark (*See* Abstract). During playback, the initial page corresponding to the initial link must be retrieved and searched for the first destination link (*See* Fig. 4A, Fig. 4B, col. 2, lines 57-66, col. 9, lines 20-31). *Anupam* performs this search to ensure that the playback of the smart bookmark will be performed seamlessly according to the intent of the creator of the smart bookmark (col. 10, lines 13-18). If the destination link is not found within the retrieved page, the retrieved page is searched for the closest matching link (*See* Fig. 5, col. 10 lines 23-55). If a matching link is not found in the retrieved page, an error message is displayed and playback of the smart bookmark is aborted (*Id.*). Thus, the invention in *Anupam* presumes that the initial page corresponding to the initial link for the smart bookmark is always retrieved, such that the initial page may always be searched for a matching link (*Id.*). If the initial page is not retrieved, the program in *Anupam* cannot search the initial page for the matching link (*Id.*). If the matching link cannot be found, the playback of the smart bookmark is aborted (*Id.*). In contrast, the present claims provide that if a first network information address stored in a bookmark data structure is not retrievable, identified embedded network information addresses are made available to a user via the stored bookmark
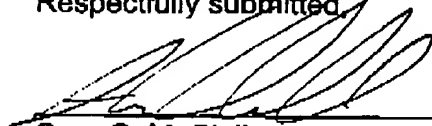
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(*See, e.g.,* Claim 1). No such processing is provided by *Anupam*. Indeed, *Anupam* suffers from a deficiency for which at least one embodiment of the present invention provides a solution, namely, how to retrieve network addresses linked from a bookmarked address that becomes irretrievable.

Thus, *Anupam*, alone or in combination with *Kanno*, does not teach, show, or suggest that if a first network information address stored in a bookmark data structure is not retrievable, identified embedded network information addresses are made available to a user via the stored bookmark.

Applicants further note that in one aspect, *Kanno* and *Anupum* are distinguishable from the presently rejected claims on the same basis. Specifically, in *Kanno, where the underlying web page is available*, a search for links is performed, similar to *Anupum*. *Kanno,* Col. 20, Lines 3-7. Thus, Applicants note that in both cases, in both *Kanno* and *Anupam*, before the search for links may take place, the bookmarked web page *must be available.* Accordingly, *Anupam* and *Kanno*, alone or in combination, at a minimum, do not teach, show, or suggest that *if a first network information address stored in a bookmark data structure is not retrievable*, identified embedded network information addresses are made available to a user via the stored bookmark. Therefore, the claims are believed to be allowable and allowance of the same is respectfully requested.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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